

REMARKS

Applicant respectfully requests entry of this Amendment, reconsideration of this application, as amended, and reconsideration of the non-final Office Action mailed on October 15, 2009. Applicant respectfully requests a one (1) month extension of time for responding to the October 15, 2009, Office Action. Applicant authorizes the Commissioner to debit our Deposit Account No. 19-0733 for this extension fee and for any other fees that are not accounted for in these papers but are nevertheless required to maintain the pending status of this application.

Upon entry of this Amendment, claims 25-29, 34-42, and 48-52 will be pending. Claims 25, 27, 34, 36, and 37 have been amended. Claims 48-52 are new. Claim 41 is canceled.

I. The Office's Objection to the Drawings

In the Office Action mailed October 15, 2009, the Office objected to the drawings for allegedly failing to show every feature of the invention specified in the claim 41. Applicant has canceled claim 41, which renders this objection moot. Applicant respectfully requests that the Office withdraw this objection.

II. The Office's Rejection Under 35 U.S.C. § 112

In the Office Action mailed October 15, 2009, the Office rejected claims 34, 35, and 37 as allegedly failing to particularly point out and distinctly claim the subject matter regarded as the invention. Applicant has amended claims 34, 35, and 37 to particularly point out and distinctly claim the subject matter of the invention. Applicant respectfully requests that the Office withdraw this rejection of these claims.

III. The Office's Rejections Under 35 U.S.C. § 102

a. § 102(b) rejection based on Ehrlich

In the Office Action mailed October 15, 2009, the Office rejected claim 25 under 35 U.S.C. § 102(b) as allegedly being anticipated by Ehrlich, Jr., U.S. Patent No. 4,177,582 ("Ehrlich"). Applicant respectfully traverses this rejection and requests reconsideration of the claim, as amended.

Applicant's independent claim 25 recites a sole for footwear comprising, "a toe part...a ball part...and an instep-heel part...[that] includes at least one cut-out that extends through an entire thickness of the heel part so that at least a portion of a wearer's foot is exposed through the cut-out when the wearer's foot is inserted into the footwear." The sole in Ehrlich does not include a cut-out that extends through the entire thickness of the heel part, as recited in Applicant's independent claim 25. The sole of the Ehrlich shoe includes solid wood portions in the forward and rearward sole part and a flexible intermediate part of foamed polyurethane. *See* Ehrlich at Abstract. The Ehrlich sole comprises materials that are completely solid. Therefore, Ehrlich does not teach at least some elements of the invention claimed in Applicant's independent claim 25, as amended. Applicant respectfully requests that the Office withdraw this rejection for at least these reasons and solicits allowance of this claim.

b. § 102(b) rejection based on Oorei

In the Office Action mailed October 15, 2009, the Office rejected claims 25 and 29 under 35 U.S.C. § 102(b) as allegedly being anticipated by Oorei, European Patent Application No. EP 1234516 ("Oorei"). Applicant respectfully traverses this rejection and requests reconsideration of the claims, as amended.

As described above, Applicant's independent claim 25 recites a sole for footwear comprising, "...an instep-heel part...[that] includes at least one cut-out that extends through an entire thickness of the heel part so that at least a portion of a wearer's foot is exposed through the cut-out when the wearer's foot is inserted into the article of footwear." The sole in Oorei does not include a cut-out that extends through the entire thickness of the heel part, as recited in Applicant's independent claim 25. The sole of the Oorei shoe is a completely solid structure that includes materials of varying rigidities. *See generally*, Ooeri. There are no "cut-outs" taught in the Ooeri reference. Therefore, Ooeri does not teach at least some elements of the invention claimed in Applicant's independent claim 25, as amended, or its dependent claim 29. Applicant respectfully requests that the Office withdraw this rejection for at least these reasons and solicits allowance of these claims.

c. § 102(e) rejection based on Bathum

In the Office Action mailed October 15, 2009, the Office rejected claims 34-39, 41, and 42 under 35 U.S.C. § 102(e) as allegedly being anticipated by Bathum, U.S. Patent No.

7,121,020 (“Bathum”). Applicant respectfully traverses this rejection and requests reconsideration of the claims, as amended. Claim 41 has been canceled, which renders its rejection moot.

Applicant’s independent claims 34 and 36, as amended, recite an article of footwear comprising: “a sole having a toe part, a ball part, an instep part, and a heel part, wherein the heel part includes at least one cut-out that extends through an entire thickness of the heel part so that at least a portion of a wearer’s foot is exposed through the cut-out when the wearer’s foot is inserted into the article of footwear;” an open toe section; an instep section; and a heel section. The running sandal described in Bathum includes a solid sole structure that has at least a midsole and an outsole constructed from a shock absorbing material. *See generally*, Bathum. The sole in the Bathum sandal is not constructed with a cut-out in any portion of the sole. Therefore, Bathum does not teach at least some elements of the invention claimed in Applicant’s independent claim 34, as amended, or its dependent claim 35, or Applicant’s independent claim 36, as amended, or its dependent claims 37-39 and 42. Applicant respectfully requests that the Office withdraw this rejection for at least these reasons and solicits allowance of these claims.

d. § 102(e) rejection based on Matis

In the Office Action mailed October 15, 2009, the Office rejected claims 34-39, 41, and 42 under 35 U.S.C. §102(e) as allegedly being anticipated by Matis, U.S. Patent No. 6,490,814 (“Matis”). Applicant respectfully traverses this rejection and requests reconsideration of the claims, as amended. Claim 41 has been canceled, which renders its rejection moot.

As described above, Applicant’s independent claims 34 and 36, as amended, recite an article of footwear comprising: “a sole having a toe part, a ball part, an instep part, and a heel part, wherein the heel part includes at least one cut-out that extends through an entire thickness of the heel part so that at least a portion of a wearer’s foot is exposed through the cut-out when the wearer’s foot is inserted into the article of footwear;” an open toe section; an instep section; and a heel section. The sole in the Matis sandal includes a solid sole structure comprising a midsole and an outsole that is adhesively attached to the midsole. Further, the Matis reference teaches that “[t]he midsole 64 is a one-piece component that is designed to be substantially coextensive with the bottom of the wearer’s foot, extending laterally and longitudinally along the sole.” *See* Matis at Col. 3, Lns. 45-48. The sole in the Matis sandal has no “cut-outs,” as recited

in Applicant's independent claims 34 and 36, as amended. Therefore, Matis does not anticipate Applicant's independent claim 34, as amended, or its dependent claim 35, or Applicant's independent claim 36, as amended, or its dependent claims 37-39 or 42. Applicant respectfully requests that the Office withdraw this rejection for at least these reasons and solicits allowance of these claims.

IV. The Office's Rejections Under § 103

a. § 103 rejection based on Bathum

In the Office Action mailed October 15, 2009, the Office rejected claim 40 under 35 U.S.C. § 103 as allegedly being unpatentable over Bathum. Applicant respectfully traverses this rejection and requests reconsideration of the claim.

As discussed above, Bathum does not teach or suggest each element of the invention claimed in Applicant's independent claim 36, as amended, upon which Applicant's claim 40 depends. Based on this dependency, Applicant's dependent claim 40 includes each element recited in Applicant's independent claim 36, as amended. Therefore, Applicant's dependent claim 40 recites at least some elements that are not taught or suggested in Bathum for at least the reasons discussed above relating to Applicant's independent claim 36, as amended. Applicant respectfully requests that the Office withdraw this rejection and allow this claim.

b. § 103 rejection based on Matis

In the Office Action mailed October 15, 2009, the Office rejected claim 40 under 35 U.S.C. § 103 as allegedly being unpatentable over Matis. Applicant respectfully traverses this rejection and requests reconsideration of the claim.

As discussed above, Matis does not teach or suggest each element of the invention claimed in Applicant's independent claim 36, as amended, upon which Applicant's claim 40 depends. Based on this dependency, Applicant's dependent claim 40 includes each element recited in Applicant's independent claim 36, as amended. Therefore, Applicant's dependent claim 40 recites at least some elements that are not taught or suggested in Matis for at least the reasons discussed above. Applicant respectfully requests that the Office withdraw this rejection and allow this claim.

c. § 103 rejection based on Ehrlich in view of Oorei and Kataoka

In the Office Action mailed October 15, 2009, the Office rejected claims 26 and 27 as allegedly being unpatentable over Ehrlich in view of Oorei and further in view of Kataoka, et al., U.S. 5,752,332 (“Kataoka”). Applicant respectfully traverses this rejection and requests reconsideration of the claims.

As discussed above, neither Ehrlich nor Oorei teach or suggest each element of the invention recited in Applicant’s independent claim 25, as amended, upon which Applicant’s claims 26 and 27 depend. Kataoka does not cure the deficiencies of Ehrlich and Oorei. Kataoka describes the use of a hard plate for a spiked track shoe. Any holes (23) described in Kataoka do not extend through the entire thickness of the sole. *See* Kataoka, Figure 2. Because the “holes” of Kataoka do not extend through the entire thickness of the sole, their structure is more similar to a cavity or an indentation than a hole. Kataoka does not describe a “cut-out” that extends through an entire thickness of the sole, as recited in Applicant’s independent claim 25, as amended. Further, the holes described in the Kataoka track spike are only located in the forefoot region of the sole. *See generally*, Kataoka. In contrast, the at least one “cut-out” recited in Applicant’s independent claim 25, as amended, is positioned in the instep-heel part of the sole. Therefore, Ehrlich in view of Oorei and further in view of Kataoka do not describe or suggest at least some of the elements recited in Applicant’s independent claim 25, as amended, and its dependent claims 26 and 27. Applicant respectfully requests that the Office withdraw this rejection and allow these claims.

d. § 103 rejection based on Ehrlich in view of Oorei, Kataoka, and Hipp

In the Office Action mailed October 15, 2009, the Office rejected claim 28 as allegedly being unpatentable over each of Ehrlich and Oorei in view of Kataoka and further in view of Hipp, et al., U.S. Patent No. 6,854,200 (“Hipp”). Applicant respectfully traverses this rejection and requests reconsideration of this claim.

As discussed above, none of Ehrlich, Oorei, or Kataoka, alone or in combination, teaches or suggests each of the elements of the invention recited in Applicant’s independent claim 25, as amended, upon which Applicant’s claim 28 depends. Hipp does not cure the deficiencies of Ehrlich, Oorei, and Kataoka. Hipp teaches a skate shield made of a resiliently flexible material that is designed to wrap around the instep of a skate for protective purposes. *See generally*,

Hipp. The structure described in the Hipp reference does not include a sole of an article of footwear. Thus, Hipp does not teach at least one “cut-out” in the sole, as recited in Applicant’s independent claim 25, as amended, and its dependent claim 28. Therefore, Ehrlich and Oorei in view of Kataoka and further in view of Hipp do not teach at least some elements of the claimed invention. Applicant respectfully requests that the Office withdraw this rejection and allow this claim for at least these reasons.

V. Conclusion

Nothing in this Amendment should be construed as an admission that Applicant agrees with or acquiesces in the various grounds of rejection that were raised by the Office in the October 15, Office Action. Rather, by this Amendment, Applicant has presented various claim amendments in an effort to expedite prosecution and to facilitate the allowance of this application. The claim changes made in this Amendment are presented without prejudice or disclaimer, and Applicant reserves all rights with respect to the originally and/or previously claimed subject matter, including the right to pursue claims of the same or similar scope in the future (*e.g.*, in a continuing application).

All rejections and objections have been fully addressed. Applicant respectfully submits that this application is in condition for allowance and respectfully solicits notification of the same.

Respectfully submitted,

By: /Holly L. Johnston/
Holly L. Johnston
Registration No. 59,496

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Banner & Witcoff, Ltd.
1100 13th Street, N.W., Suite 1200
Washington, D.C. 20005-4051
Telephone: (503) 425-6800
Facsimile: (503) 425-6801